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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/757,130 01/09/01 ENGLANDER

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EXAMINER

002352 MM91/0504
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

NGUYEN, T	PAPER NUMBER
ART UNIT	

2872
DATE MAILED:

05/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Applicati n N

09/757,130

Applicant(s)

ENGLANDER, BENJAMIN

Examin r

Thong Q Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature concerning the so-called "means for connecting" the mirror element to the mirror pole as recited in claim 1 (see Note below), and the feature concerning the treated portion located on just one side of the minor axis of the mirror surface as recited in claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Note: It is noted that 1) in figure 1, the mirror element (10) is connected to the mirror pole (12); and 2) in the specification at page 4 (lines 1-4), applicant has stated that the mirror element (10) is affixed to the mirror pole (12). With such teachings, it is unclear about the meaning of the terms "means for connecting" used in the claim 1.

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See specification at pages 3-4. See MPEP § 608.02(g).

repeat

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities: a) Page 1: lines 17-23, the specification has stated that the contents of the foreign patents are incorporated into the present application. Such an incorporation of foreign patent is not permitted by the U.S. practice. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973); b) Pages 3 and 5: There is at least one problem concerning the brief description of figures 2A-2C provided at page 3 and the description concerning the inventive device provided at pages 5+. In particular, at page 3, applicant has stated that figures 2A-2C direct to front views of several **conventional** spherical mirrors (Examiner's emphasis) ; however, in the description at pages 5+, applicant has taught that the figures 2A-2C show the treated portion of the mirror surface of the invention. As such, a correction or an explanation is required. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 3 is rejected under 35 USC 112, second paragraph because the feature "the peripheral edges" (line 3) lacks a proper antecedent basis.

b) Claim 6 is rejected under 35 USC 112, second paragraph because the feature "the oval shape" (lines 1-2) lacks a proper antecedent basis. Applicant should note that the shape of the mirror surface is recited in claim 5 (lines 1-2) and not in claim 1 in which claim 6 is a dependent claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) he has abandoned the invention.

9. Claims 1-2, 4-6 and 8 are rejected under 35 U.S.C. 102(c) because the invention has been abandoned.

The subject matter as recited in the present claims 1-2, 4-6 and 8 is described in the U.S. application, Serial No. 08/425,619 filed by the same inventor on

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04/20/1995. The invention as recited in the application '619 has been abandoned on 04/30/1996.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6 and 8, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout (U.S. Patent No. 4,822,157) in view of Beckham (U.S. Patent No. 2,711,560) and Horton (U.S. Patent No. 1,811,823).

Stout discloses a mirror assembly for use with a school bus wherein the mirror assembly is attached to a front fender of the bus for the purpose of providing the driver of the bus visual access to the area in front of the bus hood as well as to the sides of the bus. The mirror assembly as stated at column 2 and shown in figure 1 comprises a mirror element (26) secured to a mirror pole (20) via a securing means (48, 50, 52). The mirror pole (20) in turn is inherently secured to the front fender of the school bus. See column 3 and fig. 1. As such, the mirror assembly provided by Stout meets all of the limitations of the device as claimed except a portion of the mirror element taken along a vertical direction being treated for reducing glare.

However, the treatment on a portion of the mirror element for the purpose of reducing glare is known to one skilled in the art as can be seen in the optical

system provided by Beckham and Horton. In particular, Beckham discloses a windshield of an automobile and teaches that a portion of the windshield taken along a vertical direction is treated for the purpose of reducing glare. See Beckham, columns 2-4 and figs. 1-3. It is also noted that the portion being treated to reduce glare as taught by Beckham is less than one-third of the mirror surface (see figures 1 and 3, for example). In the same viewpoint, Horton discloses a rearview mirror and also teaches that a portion of the mirror element is treated for reducing glare. It is also noted that the portion being treated to reduce glare as taught by Horton is in spaced relation and is not in contact with the peripheral edge of the mirror element. See Horton, columns 1-2 and fig. 1. With regard to the feature concerning the process/method of making the treated portion as recited in present claim 4, such a feature is directed to a method/process step for making a treated portion and thus is not given a patentable weight as decided in the Courts. Furthermore, the use of a chromium plate for making a treated portion of a mirror is suggested by Horton. See column 2. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the mirror assembly as provided by Stout by making an anti-glare portion taken along a vertical direction of the mirror element as suggested by Beckham and Horton for the purpose of eliminating obscuring light rays and glare which may interfere with the driver's perception while looking into the mirror assembly.

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12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stout in view of Beckham and Horton as applied to claim 1 above with or without Hasuo (Japanese reference No. 62-192720).

The combined product as provided by Stout, Beckham and Horton as described above meets all of the features recited in present claim 7 except the treated portion is located on one side relative to the minor axis of the mirror surface. However, such an arrangement of a treated portion with respect to the area of the mirror surface as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for this conclusion is found in the present specification in which applicant has taught that the treated portion is extended on both side of the minor surface as can be seen in the embodiment described at pages 4-5 and illustrated in present figure 2A-2C. Furthermore, the use of an anti-glare portion which is located on one side of a mirror surface relative to a minor axis of the mirror surface is suggested to one skilled in the art as can be seen in the anti-glare system provided by Hasuo. See pages 150-152 and figure 5. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to use a portion on just one side of the minor axis of a mirror surface which portion is necessary to the driver's field of view as a treated portion for reducing glare and simultaneously reducing the manufacture cost.

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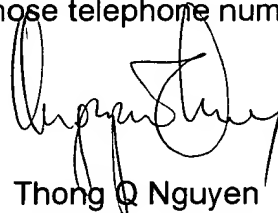
Conclusion

13. The additional references are cited as of interest in that 1) each of the U.S. Patent Nos. 1,768,354 and 1,910,503 discloses a mirror assembly having a portion taken along a vertical direction being treated for reducing glare; and 2) the U.S. Patent No. 4,938,578 discloses a mirror assembly attached to a front fender of a school bus.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q Nguyen
Primary Examiner
Art Unit 2872

April 30, 2001